

## REMARKS

### I. Status of Claims

Claims 1-58 are pending in the instant case. All the pending claims stand subject to the restriction requirement.

### II. Restriction.

The Office Action requires restriction of pending claims 1-58 to one of the following eight groups:

Group I, including claims 1-6, 23-28 and 57 (in part), drawn to a secondary alcohol compound and a method of preparing the compound, classified in class 564.

Group II, including claims 7-12, drawn to an ester compound of structural formula as shown in claim 7, classified in class 560.

Group III, including claims 13-16, 29-31 and 57 (in part) drawn to an epoxide compound of structural formula as shown in claim 13, classified in class 549.

Group IV, including claims 17, 20-22, 32-40 and 57-58 (in part) drawn to the compound, and a method of preparing of the compound, classified in class 548.

Group V, including claims 41-48, drawn to a process of preparing of a compound classified in class 548.

Group VI, including claims 49-56, drawn to another method of preparing of a compound classified in various class and subclass, depending on species election.

Group VII, including claim 58 not encompassed by Group IV, drawn to a method of preparing of a compound classified in class 548.

Group VIII, including claims 18 and 19, drawn to the intermediate compound of formula classified in class 546.

In view of the following, the applicant requests that the restriction requirement be withdrawn.

### **III. Prerequisites for a Restriction Requirement**

A proper basis for restriction involves four factors: distinctness, independence, classification, and burden to the Examiner. The MPEP mandates that if the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. See MPEP §803. Inventions related as product and process of use can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product. MPEP §806.05(h).

### **IV. Request for Withdrawal of the Restriction Requirement**

#### **A. The Applicants traverse the restriction of claim Groups IV and VIII**

##### **1. The Standard for Requiring Restriction Has Not Been Met Because the Criteria of Distinctiveness Has Not Been Demonstrated**

The restriction requirement is improper because the criteria of distinctiveness in M.P.E.P. § 806.05(c) have not been demonstrated. The claims of Group VIII and Group IV are related as combination and subcombination. Inventions in this relationship are only distinct if it can be shown that (1) the combination claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (M.P.E.P. § 806.05(c)). The M.P.E.P. requires that "the burden is on the examiner to suggest an example of separate utility" (See M.P.E.P., §806.05(c)). The Patent Office has not even alleged (2). Thus, the standard for restricting the combination from the subcombination has not been met, and restriction should not be required (M.P.E.P. § 806.05(c)).

In addition, M.P.E.P. § 806.03 advises that:

"where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth and scope of definition."

Under these requirements, the restriction between Groups IV and VIII is improper. Each of claims 17, 18, and 19 is directed to an oxazolidinone compound. Independent claim 17, which is classified in Group IV, specifies an optionally substituted aryl substituent. Dependent claims 18 and 19, which are classified in Group VIII, are also directed to an optionally substituted aryl substituted oxazolidinone compound and more particularly recites particular aryl substituents. Claims 18 and 19 are identical to claim 17, but includes the additional recitation of particular aryl substituents. The additional recitation included in claim 18 and 19 serves to more particularly specify the aryl substituent. Accordingly, claims 17, 18, and 19 all specify an optionally substituted aryl substituted oxazolidinone compound, albeit with varying breadth and scope with regards those substituents. Restriction between the claims of Groups IV and VIII, therefore, is improper.

Furthermore, the reasons provided in the office action for the distinctiveness of the Groups are unfounded. The office action asserts that "group VIII is distinct because they are art recognized divergent compounds which are structurally different from one another. Group VIII dependant claims 18 and 19, however, are dependant on the same structure as claim 17 of Group IV. Accordingly, the distinctions alleged in the office action do not exist and, therefore, the restriction requirement is improper.

For the foregoing reasons, the applicant traverses the restriction requirement on the grounds that the criteria of distinctiveness between Groups IV and VIII have not been demonstrated.

## **2. Lack of Reason for Insisting on Restriction**

In addition to a showing of distinctiveness, the M.P.E.P. requires there to be "reasons for insisting on restriction"...i.e., separate classification, status, or field of search. (See M.P.E.P., §806.05(c), citing §808.02). Likewise, the M.P.E.P. requires that search and examination of the entire application would be a serious burden on the examiner ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required." M.P.E.P. § 803).

This additional prerequisite to restriction is especially applicable in the instant application where the claims of Groups IV and VIII are both expected to be classified in U.S.

Class 548. Indeed, the assignment of the claims to separate Groups appears to have been based on a mischaracterization of the subject matter of these claims.

Moreover, a complete and thorough search directed to the subject matter of the claims of Group IV will necessarily involve a search directed to the subject matter of the claims of Group VIII. The Group VIII claims are dependant on, not independent of, the Group IV claims. The limitations recited in the Group IV claims are the first elements of the Group VIII claims. Both groups of claims are concerned with an oxazolidinone compound. A thorough search for Applicants' oxazolidinone compound comprising the (S)-intermediate (claims 17) would necessarily include within its scope a search directed to compounds comprising the particular R groups (claims 18 and 19). Accordingly, it is submitted that the claimed compounds are so closely related that all claims can be included in one search without an undue burden on the examiner and should be examined at this time. Similarly, it is submitted that intermediates wherein R<sup>1</sup> is an optionally substituted aryl group and the substructures recited in claim 18 and 19 are likewise sufficiently related such that all recited compounds could be searched simultaneously without an undue burden on the examiner. Claims readable upon the elected species include all of claims 17, 18, and 19.

Because search and examination of all of the claims can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicant and the Patent Office to prosecute the compound claims in separate applications. Search and examination of both groups of claims together would be much more efficient than requiring the Patent Office and the applicant to do so separately in two separate applications. The Applicants respectfully solicit the Examiner's discretion in examining the claims of Group IV with those of Group VIII inasmuch as including the claims of Group VIII in the scope of the search would not be unduly burdensome. As such, Applicants respectfully request that the restriction requirement, in respect to Groups IV and VIII, be withdrawn and these groups be examined simultaneously.

### **3. The Effects of the Patent Office's Position are various admissions concerning patentability**

The effect of the position in the official action is that the Patent Office admits that the Group IV claims are patentable over a disclosure of the combination of Group VIII, and vice versa. M.P.E.P. § 802.01 states that the distinctness required for restriction means that the subjects, including "combination and part (subcombination) thereof ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER" (emphasis with capital

letters in original). (See also M.P.E.P. § 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.")

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed compound of the Group VIII claims is patentable over any disclosure of a compound according to the Group IV claims. See, e.g., M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed compound of the Group IV claims is patentable over any disclosure of a compound according to the Group VIII claims. *Id.* Each of claims 17, 18, and 19 includes similar elements, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. § 806.

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicants during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

## **V. The Applicants traverse the restriction of claim Groups IV-VII**

### **1. Lack of Reason for Insisting on Restriction**

In addition to a showing of distinctiveness, the M.P.E.P. requires there to be "reasons for insisting on restriction"...i.e., separate classification, status, or field of search. (See M.P.E.P., §806.05(c), citing §808.02). Likewise, the M.P.E.P. requires that search and examination of the entire application would be a serious burden on the examiner ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required." M.P.E.P. § 803).

This additional prerequisite to restriction is especially applicable in the instant application wherein the Examiner admits that the claims of Groups IV, V, and VII are all expected to be classified in U.S. Class 548 and the claims of Group VI would be expected to

fall within this class as well. While office action asserts that the inventions "have acquired a separate status in the art as shown by their different classification" this particular allegation is improper and, therefore, the restriction requirement is improper.

All of these groups of claims are concerned with the method of making an oxazolidinone compound. There is substantial overlap in the limitations recited in the Group IV-VII claims. In view of this overlap in subject matter, it is likely that a search of methods for producing oxazolidinones as set forth in Group IV necessarily would uncover art directed to methods for producing oxazolidinones as set forth in Group V-VII, and would employ the same or similar search terms and yield the same or similar prior art as a search designed to identify art relating to such oxazolidinones. Accordingly, it is submitted that the claimed methods are so closely related that all claims can be included in one search without an undue burden on the examiner and should be examined at this time. Claims readable upon the elected species include all of claims 32-58.

Because search and examination of all of the claims can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicant and the Patent Office to prosecute the compound claims in separate applications. Search and examination of both groups of claims together would be much more efficient than requiring the Patent Office and the applicant to do so separately in two separate applications. The Applicants respectfully solicit the Examiner's discretion in examining the claims of Group IV-VIII inasmuch as including the claims of Group IV-VIII in the scope of the search would not be unduly burdensome. As such, Applicants respectfully request that the restriction requirement, in respect to Groups IV-VIII, be withdrawn and these groups be examined simultaneously.

**2. The Effects of the Patent Office's Position are various admissions concerning patentability**

The effect of the position in the official action is that the Patent Office admits that the claims of the other of Groups IV-VIII are patentable over a disclosure of the one of the Groups. Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed methods the other of the Groups IV-VIII claims is patentable over any disclosure of a method according to the one of these Groups claims. See, e.g., M.P.E.P. § 802.01. Each of claims 32-58 includes similar elements, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. § 806.

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicants during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

#### **VI. Provisional Election.**

To satisfy 37 C.F.R. 1.143, the applicants hereby provisionally elect for examination on the merits the claims of Group IV, which includes claims 17, 20-22, 32-40 and 57-58. This election is made *with traverse* at least for the reasons indicated below

The Office Action states that if Group IV is elected for prosecution, the Action further requires election of a single disclosed species is also required. The Applicants hereby elect claims directed to the following species: the intermediate wherein  $R^1$  is substituted aryl and  $R^3$  is  $C_1$ - $C_{10}$  alkyl; the carbamate wherein  $R^2$  is  $C_1$ - $C_{20}$  alkyl; secondary alcohol wherein  $R^3$  is  $C_1$ - $C_{10}$  alkyl and X is halogen; the ester wherein  $R^3$  is  $C_1$ - $C_{10}$  alkyl,  $R^4$  is  $C_1$ - $C_5$  alkyl, and X is halogen; an epoxide wherein  $R^3$  is  $C_1$ - $C_{10}$  alkyl;

In doing so, the applicants do not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

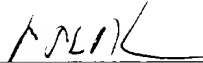
#### **VII. Conclusion**

For the foregoing reasons, reconsideration and modification or withdrawal of the restriction requirement is requested. The applicants believe that the present pending claims are in condition for allowance and the applicants respectfully requests an early and favorable action on the merits.

Should the Examiner wish to discuss this response or the referenced patent application in further detail in an effort to advance this application toward allowance, the applicants invite the Examiner to telephone or otherwise contact the undersigned.

Respectfully submitted,  
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